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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/910,849	07/24/2001	Nobuyuki Kobayashi	P21228	4815

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EXAMINER

SELLERS, DANIEL R

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 06/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/910,849

Applicant(s)

KOBAYASHI ET AL.

Examiner

Daniel R. Sellers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed February 28, 2006 have been fully considered but they are not persuasive.
2. Regarding **claim 1** rejection under 35 USC 102(b), Joshi teaches the claimed features. Joshi teaches an external memory that can have data recorded to it (Col. 3, lines 7-30). Joshi also teaches that alternatively the vendor can record this data to a second memory (Col. 7, lines 54-57), wherein it is well known at the time of the invention that certain programs require users to swap diskettes to execute the program in its entirety (e.g. video games that ran on DOS frequently required disks to be swapped when a new location in the video game was reached). Furthermore the claim language does not differentiate the type of digital data that is recorded and reproduced. A program comprises digital data that can be recorded and reproduced, and the claim language is given the broadest interpretation without reading the specification into the limitations. The rejection under 35 USC 102(b) stands as previously presented.
3. Regarding **claims 1, 2, 5, and 8**, as rejected under 35 USC 103, Tanaka teaches that the external memories can be individually identified (i.e. there's a diminishing chance that two external memories will have the same identification code when the code is long and random) (Col. 8, lines 21-30 and Col. 11, line 51 – Col. 12, line 10). Tanaka also teaches that an external memory that is not genuine will display an error message, implying that a different memory is mounted when the identification does not match (Col. 16, lines 48-53). Furthermore, it is submitted that Tanaka teaches a

recording device to record the identification data in the external memory (Col. 2, lines 16-44). It is irrelevant that individual embodiments lack certain features of other embodiments, Tanaka teaches that the embodiments can be combined in any fashion that would be obvious to one of ordinary skill at the time of invention (Col. 47, lines 47-52). The rejections under 35 USC 103(a) stand as previously presented.

4. Regarding **claims 3, 4, 6, 7, and 9-16**, as rejected under 35 USC 103 also stand as previously presented.

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. **Claim 1** is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Joshi, cited previously as pertinent non-cited art.

7. Joshi teaches a computer software security system that uses identification data in an external memory (Col. 3, lines 54-63 and Col. 4, lines 35-46). The internal memory also stores the identification data (Col. 5, lines 26-29). Joshi also teaches that a message is displayed when the two identification data's do not match (Col. 6, lines 39-64), wherein it is inherent that after a new external memory is mounted and checked the error message taught by Joshi will be displayed (Col. 6, lines 61-64).

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. **Claims 1, 2, 5, and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka.

10. Regarding previously presented **claim 1**, see Tanaka,

A digital recording and reproducing apparatus which is capable of having a removable external memory mounted therein, for performing recording of recording data in the external memory and reproduction based on the recording data recorded in the external memory, the digital recording and reproducing apparatus comprising:

an identification data-generating block that generates identification data that identifies the external memory individually; (Col. 8, lines 21-30 and Col. 11, line 51 – Col. 12, line 10)
an internal memory in which the identification data can be recorded; and (Col. 8, lines 16-20).
a control block that records the identification data in the external memory and said internal memory, and carries out identification data determination processing that determines, when mounting of the external memory is detected, whether or not the identification data recorded in the external memory and the identification data recorded in said internal memory are identical to each other, (Col. 8, lines 31-62) and to display a message that notifies a different external memory has been mounted when the identification data are different from each other (Col. 16, lines 37-57).

Tanaka teaches these features in several different embodiments and combinations thereof (Col. 16, lines 2-12),. In a first embodiment Tanaka teaches a identification data-generating block and they also teach that an internal memory containing the identification is compared to the external memory's identification data for the purpose of copyright management. Tanaka teaches that the first embodiment can provide different ways to restrict the playback of audio or video, and it is inherent that a playback device has a display device, however the first embodiment does not teach the display of a message with these features. In a fourth embodiment, Tanaka teaches that an error message can be displayed when data does not match the expected data in a data field, which is separate from the CIS field (see Fig. 5). Similar to the first embodiment (Col. 8,

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lines 31-39), Tanaka teaches that the JD (judge means) also detects the differences between expected values and recorded values (Col. 18, lines 25-45). It would have been obvious at the time of the invention to have restricted the playback of audio with an error message for the purpose of providing visual feedback to the user.

11. Regarding **claim 2**, the further limitation of claim 1, see Tanaka,

... wherein said control block records the identification data in both of the external memory and said internal memory before the recording data is recorded in the external memory. (Col. 7, lines 18-23).

Tanaka teaches this feature.

12. Regarding **claim 5**, the further limitation of claim 1, see the preceding argument with respect to claim 1. Tanaka teaches that the identification data-generating block generates random numerical data.

13. Regarding **claim 8**, the further limitation of claim 2, see the preceding argument with respect to claims 2 and 5. Tanaka teaches the features of claims 2 and 5.

14. **Claims 3, 4, 9, and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka as applied to claim 2 above, and further in view of Kubo, U.S. Patent No. 6,631,427.

15. Regarding **claim 3**, the further limitation of claim 2, see Tanaka,

... wherein said control block carries out the identification data determination processing when the external memory is mounted after having been removed during recording of the recording data in the external memory, said control block continuing to record the recording data in the mounted external memory when the identification data recorded in the external memory and the identification data recorded in said internal memory are identical to each other, and carrying out predetermined error-handling processing when the identification data recorded in the external memory and the identification data recorded in said internal memory are different from each other. (Col. 2, line 63 – Col. 3, line 2).

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Tanaka teaches the predetermined error-handling in a memory system. Tanaka teaches that the identification data is compared to determine whether or not the data can be used. Tanaka does not teach the step of recording the data to the memory system. Kubo teaches the recording of digital data to a memory device (Col. 1, lines 41-53). Kubo teaches that the discriminating means decide whether or not recording can be done on the memory. It would have been obvious for one of ordinary skill in the art to combine the teachings of Tanaka and Kubo for the purpose of creating a protected removable data system.

16. Regarding **claim 4**, the further limitation of claim 2,

... wherein said control block causes the recording data to be recorded in said internal memory when the external memory is removed during recording of the recording data in the external memory, carries out the identification data determination processing when the external memory is mounted, and records the recording data recorded in said internal memory in the mounted external memory when the identification data recorded in the external memory and the identification data recorded in said internal memory are identical to each other.

Tanaka teaches the features of claim 2, and teaches the identification data determination processing when the external memory is mounted. Tanaka does not teach the recording of data to an internal memory. Kubo teaches that the recording process records to the internal memory when the external memory is removed during recording (Col. 1, lines 32-38 and lines 49-53). Kubo teaches that the recorded data in the internal memory is recorded to the external memory (Col. 6, lines 40-45).

17. Regarding **claim 9**, the further limitation of claim 3, see the preceding argument with respect to claims 3 and 5. The combination of Tanaka and Kubo teach these features.

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18. Regarding **claim 10**, the further limitation of claim 4, see the preceding argument with respect to claims 4 and 5. The combination of Tanaka and Kubo teach these features.

19. **Claims 6, 7, 11, and 14** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka as applied to claims 1 and 5 above, and further in view of Pawlowski et al., U.S. Patent No. 6,038,199 (hereinafter Pawlowski).

20. Regarding **claim 6**, the further limitation of claim 1,

... wherein the recording data is sound data, and wherein the digital recording and reproducing apparatus includes a sound signal input block for inputting an analog sound signal, a sound data generation block for generating the sound data by converting the analog sound signal to digital data and compressing the digital data, a sound signal generation block for decompressing the sound data recorded in the external memory to generate the digital data and converting the digital data to the analog sound signal, and an amplifier circuit for amplifying the converted analog sound signal to output the amplified sound signal.

Tanaka teaches the features of claim 1, however Tanaka does not teach the sound processing blocks as described by these limitations. Pawlowski teaches a portable digital audio recorder. The device has the sound signal input block (Fig. 3, unit 56), the sound data generation block, and the sound signal generation block (Fig. 3, units 52 and 54) for outputting an amplified signal (Fig. 3, unit 58) from an external memory (Fig. 3, unit 64). It would have been obvious for one of ordinary skill in the art to combine the teachings of Tanaka and Pawlowski for the purpose of creating protected audio works.

21. Regarding **claim 7**, the further limitation of claim 5, see the preceding argument with respect to claim 6. Tanaka teaches the features of claim 5, and therefore the combination of Tanaka and Pawlowski teach the features of claim 7.

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22. Regarding **claim 11**, the further limitation of claim 2, see the preceding argument with respect to claims 2 and 6. The combination of Tanaka and Pawlowski teach these features.

23. Regarding **claim 14**, the further limitation of claim 8, see the preceding argument with respect to claims 6 and 8. The combination of Tanaka and Pawlowski teach these features.

24. **Claims 12, 13, 15, and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Tanaka and Kubo as applied to claim 3 above, and further in view of Pawlowski.

25. Regarding **claim 12**, the further limitation of claim 3, see the preceding argument with respect to claims 3 and 6. The combination of Tanaka and Kubo teach the features of claim 3, however they do not teach the sound processing blocks as described by these limitations. Pawlowski teaches a portable digital audio device with these features. It would have been obvious for one of ordinary skill in the art to combine the teachings of Pawlowski with the combination of Tanaka and Kubo for the purpose of creating protected audio works.

26. Regarding **claim 13**, the further limitation of claim 4, see the preceding argument with respect to claims 4 and 6. The combination of Tanaka, Kubo, and Pawlowski teach these features.

27. Regarding **claim 15**, the further limitation of claim 9, see the preceding argument with respect to claims 6 and 9. The combination of Tanaka, Kubo, and Pawlowski teach these features.

28. Regarding **claim 16**, the further limitation of claim 10, see the preceding argument with respect to claims 6 and 10. The combination of Tanaka, Kubo, and Pawlowski teach these features.

Conclusion

29. The applicant is reminded that Technology Center 2600 has undergone restructuring as of March 19, 2006. Any **further communication** regarding this application should **indicate the new Art Unit 2615** (old art unit 2644).

30. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel R. Sellers whose telephone number is 571-272-7528. The examiner can normally be reached Monday to Friday, 9am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571)272-7564. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DRS



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SUPERVISORY PATENT EXAMINER